

### REMARKS

Reconsideration of the rejections set forth in the Final Office Action mailed August 11, 2004, is respectfully requested. Claims 47, 56, and 58-60 have been amended. Claims 47-63 remain pending in this case. Claim 56 and 58-60 has been amended to further clarify the invention without narrowing the scope of the claim. Support for these amendments can be found in the specification at, e.g., page 3, line 28 – page 4, line 4 and page 6, line 30 – page 7, line 21. Therefore, these amendments are made without introducing new matter.

#### Art Rejections

Claims 47-63 were rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Eggers et al. (USP 6,514,248). Applicants have amended independent claim 47 to require the step of “*rotating the separator element about the axis to substantially separate a tissue section from surrounding tissue before radially retracting the tissue separator element.*” (emphasis added). Eggers et al. does not teach or suggest this step. In contrast, Eggers et al. describes methods of separating tissue that do not rotate the separator element about the axis to substantially separate the tissue section element about the axis before radially retracting the tissue separator element. Eggers states, “[w]ith this system, typically a volume of targeted tissue such as tumor is isolated by a cut providing necrotic interfacing cut surfaces having a resultant circumscribing volume shape resembling a segment of an orange.” (Col. 5, lines 39-42). As seen in Figs. 3A-E and 6A-C, the tissue section is separated by manipulating the instrument to follow the paths outlined in the figures. (See, e.g., Col. 11, line 7 – Col. 12, line 5). In order to separate the tissue section, as seen in Fig. 3C, “while the forward end region 50 is at the angular orientation  $\theta = \theta_1$ , [the tissue separating element] is retracted toward the deployment portion 80

while carrying out electrosurgical cutting as represented by the cut indicator line.” (Col. 11, lines 42-45, emphasis added). Claim 47 is therefore patentably distinct from the cited art. Claims 48-55 are dependent on claim 47 and are therefore patentably distinct from the cited art for the same reasons cited above.

Claim 56 requires the steps of “moving a tissue holding element, located at the distal end of the catheter assembly, from a retracted condition to an extended, tissue engaging condition” and “surrounding the separated tissue section with the tubular braided element by moving the tubular braided element, located at the distal end of the catheter assembly, from a proximal, radially contracted state to a distal, radially expanded state following the rotating step.” (emphasis added). Applicant respectfully asserts that Eggers does not teach or suggest a method for creating a tissue section containing all of the limitations of the claim 56. Claims 57-63 are dependent on claim 56 and are therefore patentably distinct from the cited art for the same reasons cited above.

Therefore, applicants respectfully assert that the prior art does not teach or suggest each and every limitation of the claims as amended and request withdrawal of the rejections.

**CONCLUSION**

For all the foregoing reasons, Applicant asserts the claims are in condition for allowance. Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicant's undersigned representative at (949) 737-2900. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 50-2862.

Respectfully submitted,

O'MELVENY & MYERS LLP

Dated: \_\_\_\_\_

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